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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/630,938	08/02/2000	MICHEL LUSSIER	ADI-022	8689

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EXAMINER

PATTERSON, MARIE D

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 03/18/2003

22

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/630,938

Applicant(s)

LUSSIER, MICHEL

Examiner

Marie Patterson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-23,26-31 and 35-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-23,26-31 and 35-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 February 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 26, 29, and 30 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Crowley (4393604).

3. Claims 1, 4-9, 19-21, 26-29, and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Tong (5185943).

Tong shows a “generally” planar chassis (120, figure 16) with elongate elements (122) in the forefoot area and elongate elements in the rearfoot area (see figure 16) and a cleat (either elements 34 or elements shown at number 24 in figure 1) as claimed.

In reference to claim 35, the encapsulating midsole material (see column 8 lines 36-40) is considered to be a “skin” as recited in the claims.

In reference to claim 39, the spaces between the elongate elements are curved and therefore are nonlinear as claimed.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 26 and 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Trolle (1141889) in view of Barma (5546680).

Trolle shows a shoe comprising a chassis (A) which extends the entire length and width of the shoe sole and a lug (11 or 12) which extends from the bottom of the chassis for connection to a cleat (C or D) substantially as claimed except for the exact materials for the chassis. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use polymeric materials since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416. Barma clearly teaches that it is known to use tough rigid plastics, i.e. polymeric materials, for protective plates/chassis (see column 3 lines 1-7 and lines 55-60) as an alternative to metals.

6. Claims 1, 4, 6-10, 19, and 26-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lorenzi (1684676).

Lorenzi shows a shoe with a chassis (4) with elongate elements (shown in figure 1) in the heel and forefoot areas, and a cleat (13) substantially as claimed except for the exact materials for the chassis. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use polymeric materials since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

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In reference to claim 10, the shape of the opening is considered to be a choice of design and it would have been obvious to make the opening in the shape of a chevron to make the opening easier to manufacture/cut.

7. Claims 1, 5, 6, 8-10, 12-23, and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giese (5572805) in view of Tong (5185943) or Brown (D446917) and Thomas (444735).

Giese (figures 111-116) shows a shoe sole with a chassis substantially as claimed except for the extent of the forefoot elements. Either Tong or Brown teaches extending forefoot elongated elements through the entire forefoot area (see figures 16 or figure 2). In reference to the exact orientation of Brown in a shoe, Thomas shows/teaches how such a shaped element would be placed in a shoe as one of ordinary skill in the art would have known to be inherent or at least obvious in the Brown reference due to the curved shape of the ends of the insert being the same as the known curved shape of conventional footwear. It would have been obvious to extend the forefoot elements as taught and shown by either Tong or Brown in the shoe of Giese to provide support for the entire length of the foot.

In reference to claim 4, Tong specifically teaches and shows the use of three elongate forefoot elements (122). Also, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide multiple elongate elements including three, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

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In reference to claim 10, the shape of the opening is considered to be a choice of design and it would have been obvious to make the opening in the shape of chevron to make the opening easier to manufacture/cut.

In reference to claims 17 and 18, Giese teaches the well known use of different materials to provide different properties in different areas (column 13 lines 15-40). It would have been obvious to use different materials in different regions of the chassis of Giese as modified above to provide increased flexibility in areas which require such.

8. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 1, 5, 6, 8-10, 12-23, and 39 above, and further in view of Kendall (5713143).

Giese as modified above shows a chassis substantially as claimed except for the opening being open to the side. Kendall teaches opening a heel area to the side in a chassis. It would have been obvious to provide a side opening as taught by Kendall in the chassis of Giese as modified above to increase flexibility and comfort in the heel.

9. Claims 26-30 and 35-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 1, 5, 6, 8-10, 12-23, and 39 above, and further in view of Crowley (4393604).

Giese as modified above shows a shoe substantially as claimed except for cleats on the sole. Giese suggests different contours for the outsole to increase traction of the sole (column 14 lines 20-23). Crowley teaches forming an outsole with molded cleats thereon as is well known. It would have been obvious to provide cleats as taught by Crowley on the outsole of Giese as modified above to increase traction.

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In reference to claims 35-38, Giese as modified above shows a shoe sole with a skin layer (the bottom layer in figures 112-115), an intermediate film (shown in figures 112-115, which inherently has color), and a chassis (19). The use of transparent materials for the outser sole elements is extremely well known to allow an intereior element to be seen. It would have been obvious to make the outer skin layer transparent as is well known in the shoe of Giese as modified above to allow the interior elements to be seen.

10. Claims 30 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 26-30 and 35-38 above, and further in view of Cameron (3739497) or Barre (5473827).

Giese as modified above shows a shoe substantially as claimed except for providing a lug on the chassis which extends into the cleat. Cameron or Barre teaches providing lugs (32 or 23) on a chassis which extends into a cleat (24 or 11). It would have been obvious to provide lugs which extend into the cleat as taught by either Cameron or Barre in the shoe of Giese as modified above to increase stability and durability of the layered sole.

Response to Arguments

11. Applicant's arguments filed 2/25/03 have been fully considered but they are not persuasive. .

In response to applicants' arguments directed towards the chassis of Tong not being "planar", it is noted that the claims recite that the chassis is "generally planar" and the chassis of Tong is considered to be "generally planar".

In response to applicants' arguments directed towards the references addressing a "different problem" and the citation of *Lindemann Maschinenfabrik FMBH v. American Hoist and Derrick Company et al* 221 USPQ 481, it is noted that all of the applied references are directed towards shoe soles and address stiffness and stability problems. The case law cited is directed towards devices which are "entirely different device, composed of parts distinct from those of the claimed invention, and operating in a different way to process different material differently" (page 485 last line of decision-line 1 of page 486 of the decision under the section titled "I. Anticipation"). This clearly is not the same facts or situation as those in this application. The references are clearly directed towards shoe sole parts which operate to protect and support the foot of a wearer and which are intended to be worn by humans. It is noted that "the question of obviousness however is so closely tied to the facts of each particular case, that the prior decisions in cases involving different facts are ordinarily of little value in reaching a decision" (*In re Lainson*, 52 CCPA 880, 339 F2d 252, 144 USPQ 19 (1964)). Also, it is not an invention to perceive that the product which others had discovered had qualities they failed to detect. (*National Distillers and Chemical Corporation v. Brenner*, 156 USPQ 163, 854 OG 844) The law of anticipation does not require that the reference teach what the appellant is claiming, but only that the claims "read on" something disclosed in the reference, i.e. all limitations of the claim are found in the reference. (*Kalman v. Kimberly Clark Corp.* 713 F2d 760, 218 USPQ 871 (Fed Cir 1983))

In reference to applicants arguments directed towards the teachings of Brown, it is noted that a reference must be considered not only for what it expressly teaches, but

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also for what it fairly suggests (In re Lamberti 192 USPQ 278, In re Burckel 201 USPQ 67) and what an artisan logically draws from a reference (In re Shepard 138 USPQ 148). One of ordinary skill in the art would clearly consider the insert/chassis of Brown as being intended to extend from the toe to the heel portion of footwear due to the curved shape of the periphery of the insert being the same as that of conventional and well known footwear. Also, the reference to Thomas clearly shows/teaches how a substantially same shaped element conventionally fits in footwear.

1. Telephone inquiries regarding the status of application or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the Examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148 or the **Tech Center 3700 Customer Service Center number is (703) 306-5648**. For applicant's convenience, the Group Technological Center FAX number is (703) 872-9302. (Note that the Examiner **cannot** confirm receipt of faxes) Please identify Examiner ____ of Art Unit ____ at the top of your cover sheet of any correspondence submitted.

Inquiries only concerning the **merits** of the examination should be directed to Marie Patterson whose telephone number is (703) 308-0069.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g. copies of references cited, form PTO-1449, for PTO-892, etc. requests for copies of such papers should be directed to (703) 308-1337.

Check out our web-site at "www.uspto.gov" for fees and other useful information.



Marie Patterson
Primary Examiner
Art Unit 3728